

REMARKS

In response to the Office Action mailed December 10, 2001, Applicants elect with traverse to prosecute the claims of Group IV drawn to methods of diagnosing breast cancer. In particular, Applicants traverse the restriction between groups IV and XVI. The claims of Group XVI are drawn to methods of determining prognosis.

According to the MPEP, where claims can be examined together without undue burden, the Examiner must examine the claims on the merits even though they are directed to independent and distinct inventions. See, the MPEP at 803.01. In establishing that an "undue burden" would exist for co-examination of claims, the Examiner must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. To show undue burden resulting from searching difficulties, the Examiner must show that the restricted groups have a separate classification, acquired a separate status in the art, or that searching would require different fields of search (MPEP at § 808.02). Applicants respectfully submit that all of the inventions in the present application can readily be searched without undue burden. As such, at the very least, Applicants request that the Examiner join Groups IV and XVI because a search for one of the groups will identify art pertaining to the other.


In addition, to claim the subject matter of the invention more particularly, claim 7 and 31 have been canceled and new claims 32-49 have been added. Claims 32-44 are drawn to methods of diagnosing breast cancer (group IV) and claims 45-49 are drawn to methods of prognosis of breast cancer (group XVI). Claims 32-49 add no new matter. These claims all find support in the originally filed claims and in the specification. In particular claims 32-44 find support in original claim 7 and in the specification on page 6, lines 1-28, page 16, lines 14-23 and page 22, lines 7-19. Claims 45-49 find support in original claim 31 and in the specification on page 6, lines 1-28, page 16, lines 14-23 and page 22 lines 7-19.

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If a telephone call would expedite prosecution of this application, the
Examiner is invited to telephone the undersigned at 415-576-0200.

Respectfully submitted,



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